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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,059	07/29/2003	Steven Tisma	204280-9001	5861
1131	7590	03/10/2004		
MICHAEL BEST & FRIEDRICH LLC 401 NORTH MICHIGAN AVENUE SUITE 1700 CHICAGO, IL 60611-4212			EXAMINER NASH, BRIAN D	
			ART UNIT 3721	PAPER NUMBER

DATE MAILED: 03/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/629,059

Applicant(s)

TISMA, STEVEN

Examiner

Brian D Nash

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,6,9,11,13 and 14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,6,9,11,13 and 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 10/02/2003.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Examiner's Comments*

1. This action is a continuation of application 09/694,971 which is now US Patent No. 6,629,403 B1. The pending claims are 1-2, 6, 9, 11, and 13-14.

### *Drawings*

2. The drawings are objected to because the cam follower (70) and coupled elements (68,64) appear to be protruding out from the plane of the page in Figure 11. This contradicts the description of Figure 11 found in the specifications. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### *Double Patenting*

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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4. Claims 1-2, 6, 9, 11, and 13-14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 6,629,403 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because US 6,629,403 B1 to Tisma substantially anticipates all structural limitations of the invention as presently claimed.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 11 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 11 recites the limitation "the resilient biasing means" in line 9. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 6, 9, 11, and 13-14 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,072,573 to Tisma. Tisma discloses the same invention including an automatic packaging

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machine having a conveyor (74,76 – see also column 1, lines 55-59) for moving a plurality of mandrels (20) around a closed track (see Fig. 7), a cam track (110) extending between a chain conveyor, and wherein each mandrel has a plurality of fingers (30,32) in order to grip or release one of a plurality of objects having different widths, a means (132,134,136,138) that is independently responsive to the contours of two cam tracks (124,126) and cam followers (128,130) which can cause the fingers grip a box having a non-parallelepiped shape (see Figs. 10-11 and column 4, line 55 to column 5, line 13). Tisma further show the packaging machine track to have a plurality of support platforms and contours that define work station locations (see Fig. 7). Tisma also shows a packaging machine wherein each mandrel has spring biasing means (140, 142, 144, 146), supports (36,38) having a plurality of threaded holes defining locations of the fingers (see Fig. 1) and a support plate (44) having two pairs (40,46,48) and (42,50,52) of oppositely-disposed and vertically-aligned elongated tracks.

Examiner notes that the spring means pull the fingers together in a “gripping” motion via spring tension which is variable due to the movement of the side bars (36,38) which are connected to the fingers, thereby making the gripping of the fingers responsive to the cam follower. Tisma discloses the fingers to be automatically adjusted to accommodate objects of different widths (see column 1, lines 45-52).

Regarding claim 9, Tisma discloses the ability of moving only one finger, thereby accommodating non-parallelepiped objects (see column 5, lines 1-4).

Regarding claim 13, Tisma shows a support plate (44) having a plurality of holes defining the locations of said fingers (30,32 - see also Fig. 1). These holes have threads to accommodate screws.

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Regarding claim 14, Tisma shows an alternate embodiment having at least four fingers that move together and apart within a range to grip and release objects (150,152 – see Fig. 11).

***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Tisma '680 and Reil et al are cited to show related references.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Nash whose telephone number is (703) 305-4959. The examiner can normally be reached on Monday – Thursday from 8 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I. Rada can be reached at 703 308-2187.

The fax number for this Group is: 703-872-9306

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1148.

Brian D. Nash  
27 February 2004



Rinaldi I. Rada  
Supervisory Patent Examiner  
Group 3700